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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,283	11/24/2000	Frank A. Cardenas	4172P2241	3014

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EXAMINER



GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No. 09/718,283	Applicant(s) CARDENAS, FRANK A.	
	Examiner Yogesh C Garg	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoang et al. (US Patent 6,449,052 B1), hereinafter, referred to as Hoang and further in view of Cohen et al. (US Patent 6,505,171 B1), hereinafter, referred to as Cohen.

Regarding claim 1, Hoang in view of Cohen teaches a system for secure and private on-line shopping comprising, in combination:

Hoang discloses:

an on-line shopping store comprising a plurality of computers for accessing on-line retailers;

an on-line shopping store server coupled to the plurality of computers of the on-line shopping store for hosting an on-line shopping store web site;

(see at least col. 2, lines 5-22, and col.2, line 60-col.3, line 50, "According to the present invention, an electronic commerce method and system for referencing remote merchant sites at a local commerce site is provided. The local commerce site may also be a remote merchant integration server (RMIS). The remote commerce site may also be a remote merchant site. The remote merchant site

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may be a website of a merchant. The method can be implemented on an individual computer or a network of computers. The network of computers can be a local area network, a wide area network, an intranet, an extranet, an internet, or the Internet.In a specific embodiment, the traffic relaying includes generating the processed client request related to the client request and sending the processed client request to the remote merchant site if the processed client request meets certain criteria. ". Note: The local remote commerce site corresponds to the an online shopping store/store web site coupled to a plurality of remote commerce sites, which correspond to a plurality of retailer servers/computers).

Hoang further discloses purchasing products and services on Internet (see col.2, lines 5-8). It will be inherent to make payments when you make purchases. Hoang does not disclos :

an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a prepaid card having an assigned monetary value and a shopping card server coupled to the on-line shopping store server for verifying authenticity and monetary value of the on-line store shopping card, for crediting and debiting the monetary value of the on-line store shopping card, and for transferring payments to and from a user of the on-line store shopping card and the on-line retailers.

However, in the same field of endeavor, Cohen discloses an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a prepaid card having an assigned monetary value and a shopping card server coupled to the on-line shopping store server for verifying authenticity and monetary value of the on-line store shopping card, for crediting and debiting the monetary value of the on-line store shopping card, and for transferring payments to and from a user of the on-line store shopping card and the on-line retailers (see at least col.4, lines 16-48, "*Referring now to FIG. 1, a transaction system, generally designated 30, for handling purchasing transactions between a first party 31, typically a consumer, and a second party 33, typically a merchant, over a global computer network 32 such as the*

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Internet is provided in accordance with a preferred embodiment of the present invention. The purchasing transactions are processed by a third party administrator 35. A trio of computers including a consumer computer 39, a merchant computer 41, and an administrative computer 52 ensures each party maintains or has access to a presence on the network which serves as the communication medium between the parties. A plurality of pre-paid cards 34, which are generated by the third party administrator 35 and maintained at a distribution site 36, facilitate the purchasing transaction by providing a medium of exchange between the three parties. At least part of the transaction is processed by the third party administrator 35 who maintains and operates a transactional computer program 37 for processing consumer and merchant related information and stores such information in a transactional database 46..... A pre-paid card purchasing option 50 is provided within such display site 40. Selection of the purchasing option 50 transfers the consumer 31 to the administrative computer 52 which generates a preformatted display page 102 (FIG. 8) substantially duplicating the merchant's display and handles the fund verification portion of the transaction. An administrative repository 62 and a merchant repository 64 further handle the transfer of funds between the parties. The components of such system 30 will now be described in more detail. ". Note: The pre-paid card corresponds to the on-line store shopping card, the third party administrator 35 and the administrative computer 52 corresponds to a shopping on-line card server coupled to the on-line store server already disclosed by Hoang and analyzed above. This administrative computer verifies the authenticity and implements the crediting and debiting the monetary value of the on-line pre-paid shopping card and for transferring payments to the merchants/on-line retailers as claimed in the application).

In view of Cohen, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Hoang to incorporate the features of an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a prepaid card having an assigned monetary value and a shopping card server coupled to the on-line shopping store server for verifying authenticity and monetary value of the on-line

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store shopping card, for crediting and debiting the monetary value of the on-line store shopping card, and for transferring payments to and from a user of the on-line store shopping card and the on-line retailers. Doing so would help : (1) to process the payment and close the transaction by using pre-paid debit cards, which would help in preventing credit card fraud, avoiding excessive debt, and (ii) further helping the retailer web sites by relieving them from the burden of verification/authentication process, processing payment, and fulfillment of the orders and therefore freeing the valuable resources of the retailer web site to focus on displaying and marketing their products/services.

Regarding claim 2, Hoang/Cohen as applied to claim 1 discloses at least one home computer coupled to the on-line shopping store server for accessing on-line retailers (see at least Hoang, FIG.1, user client computer corresponds to a home computer. The user client can be anywhere depending upon the user's location that is at home, office, etc.).

Regarding claim 3, Hoang/Cohen as applied to claim 2 teaches a system for secure and private on-line shopping . Cohen further teaches comprising an outside server coupled to the on-line shopping store server and the on-line shopping card server for accessing web sites that not located on the on-line shopping store server (see at least col.7, lines 43-52, "*The third host is an administrative server 52 that communicates with the consumer host 39 and merchant host 41. Such administrative server maintain an activation web site 42, generate and store preformatted displays 102, communicate with other network servers and a fund repository 62, verify the viability of a purchasing transaction, and maintain at least one transactional database 46 capable of storing a plurality of user records 44* ". Note: communicating with other network servers correspond to accessing web sites that not located on the on-line shopping store server). In view of Cohen,

it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Hoang/Cohen as applied to claim 2 to incorporate the feature of accessing web sites that not located on the on-line shopping store server. Doing so would help : (1) to access bank servers/server of the issuer of the pre-paid cards to check the authenticity and (ii) further helping in connecting to other merchant sites to do comparison shopping as suggested in Cohen (see col.2, lines 5-8).

Regarding claim 4, Hoang/Cohen as applied to claim 1 discloses that on-line retailers are formed into a single network of sites and are hosted on the on-line shopping store server (see at least col. 2, lines 5-22, and col.2, line 60-col.3, line 50, "*According to the present invention, an electronic commerce method and system for referencing remote merchant sites at a local commerce site is provided. The local commerce site may also be a remote merchant integration server (RMIS). The remote commerce site may also be a remote merchant site. The remote merchant site may be a website of a merchant. The method can be implemented on an individual computer or a network of computers. The network of computers can be a local area network, a wide area network, an intranet, an extranet, an internet, or the Internet.In a specific embodiment, the traffic relaying includes generating the processed client request related to the client request and sending the processed client request to the remote merchant site if the processed client request meets certain criteria.*". Note: The local remote commerce site corresponds to the an online shopping store/store web site coupled to a plurality of remote commerce sites, which correspond to a plurality of retailer servers/computers).

Regarding claim 5, Hoang/Cohen as applied to claim 1 discloses that the on-line shopping server host a home web page having hyperlinks to the on-line retailers (see at least

col.1, lines 1-48, “ *The present invention relates generally to a distributed network of hyperlinked document.....*”).

Regarding claims 6 , 7, & 9, Hoang/Cohen as applied to claim 1 discloses that the on-line shopping card has an identification number which is used when purchasing goods from the on-line retailers and the identification number is located on the on-line shopping card or on a piece of paper attached to the on-line shopping card (see at least Cohen, FIG.3 which represents the shopping pre-paid card displays an identification number located on the card, col.4, line 49-col.5, line 3). In view of Cohen, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Hoang/Cohen as applied to claim 1 to incorporate the feature that the on-line shopping card has an identification number which is used when purchasing goods from the on-line retailers and the identification number is located on the on-line shopping card. Doing so would help : (1) to identify the pre-paid card and correlate it for verification/authentication so that payment can be transferred from the card to the merchant, and (ii) further helping the consumers to read the identification number from the card /or from a piece of paper like a printed receipt, as it is widely practiced when using the credit-cards.

Regarding claim 10, Hoang/Cohen as applied to claim 1 also discloses that the on-line shopping card is a programmable on-line shopping card (see at least Cohen col.5, lines 30-36, “ *expensive technology associated with so-called smart cards which typically include a chip or magnetic strip embedded into the card surface.....*”). Note: The smart cards correspond to programmable on-line shopping cards. Here, Cohen discloses the use of smart cards, as an admitted prior art explicitly disclosing that information from these cards can be read by using a card reader and that information can include information about the user). In view of Cohen, it would have been

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obvious to a person of an ordinary skill in the art to have modified Hoang/Cohen as applied to claim 1 to incorporate the feature of smart card because by doing so it allows an alternative to use IC-cards for receiving relevant information stored in the cards and also to store/transmit information to these smart cards, like adding monetary value, etc.

Regarding method claims 11-16, their limitations correspond to the functional limitations of the system claims 1-6 and are therefore analyzed and rejected as being unpatentable over Hoang/Cohen on the basis of same rationale.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being obvious over Hoang/Cohen as applied to claim 7 in view of an Official Notice.

Regarding claim 8, Hoang/Cohen as applied to claim 7 discloses that the on-line shopping card has an identification number which is used when purchasing goods from the on-line retailers and the identification number is located on the on-line shopping card or on a piece of paper attached to the on-line shopping card. Hoang/Cohen as applied to claim 7 does not disclose that the identification number located on the on-line shopping card is covered with a removable opaque adhesive tape. The examiner takes an Official Notice of the well-known concept and benefits of covering the identification number located on the on-line shopping card is covered with a removable opaque adhesive tape for the obvious reason of not displaying it to the unauthorized people and in case if it has removed then it will indicate that the card has been tampered by unauthorized people and thereby caution the user to alert the concerned authorities.

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4. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoang in view of Cohen.

Regarding claim 17, Hoang in view of Cohen as applied to claims 1 & 6 already covers the following limitations:

A method for making secure and private on-line purchases comprising the steps of:
providing an on-line shopping store having a plurality of computers for accessing on-line retailers;

providing an on-line shopping store server coupled to the plurality of computers of the on-line shopping store for hosting an on-line shopping store web site;

purchasing an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a pre-paid card having an assigned monetary value and identification number;

entering the identification number of the on-line store shopping card;
verification of the identification number and funds remaining on the on-line store shopping card.

Hoang/Cohen also discloses: selecting goods and items to purchase and entering a delivery location of the goods and items purchased when the identification number and funds are verified (see Cohen at least col.6, line 61-col.7, line 16) for the obvious reason of permitting the customer to have his choice in purchasing the goods and also to allow the system to fulfill the order by shipping the order at the designated address.

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Regarding claim 18, Hoang/Cohen as applied to claim 17 further discloses the step of assigning a Personal Identification Number (PIN) to the on-line store shopping card (see at least col.8, lines 4-13, "*password 81*" corresponds to PIN).

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoang/Cohen and further in view of Yamada (US Patent 6,336,100 B1).

Regarding claim 19, Hoang/Cohen as applied to claim 17 teaches a method for making secure and private on-line purchases and entering a delivery location of the goods and items purchased. Hoang/Cohen as applied to claim 17 does not disclose:

selecting the on-line shopping store as the delivery location; and

calling a purchaser when the goods and items purchased have arrived at the on-line shopping store.

However, Yamada, in the same field of endeavor, teaches selecting the on-line shopping store as the delivery location (see at least col.1, lines 32-44, col.5, lines 13-29, and col.5, lines 46-64. Note: Customer's designated place where the commodity should be delivered covers the claims limitation because that can include broadly any place convenient to customer including the online store, his residence, his office, or any other location) and calling a purchaser when the goods and items purchased have arrived at the on-line shopping store (see at least col.3, lines 43-48, "*.....The server 1 then transmits the date information to the terminal equipment 3a of the customer...*"). Note: informing the customer about the delivery of items at the designated delivery station corresponds to the claimed limitation. The process of informing could be a choice such as informing by telephone, or mail or e-mail, etc. and such design choices are well-known and are subjective in nature which does not warrant a patentable distinctness over the prior art of

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Yamada.). In view of Yamada, it would have been obvious to a person of an ordinary skill in the art to have modified Hoang/Cohen as applied to claim 17 to incorporate the feature of selecting the on-line shopping store as the delivery location and calling a purchaser when the goods and items purchased have arrived at the on-line shopping store because by doing so it provides the purchase the flexibility and convenience to him to take delivery from a location of his own choice as explicitly disclosed in Yamada.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Pub.No: 2001/0029496 A1 to Otto et al. discloses a method and an apparatus for providing anonymous financial transactions including purchasing and asking for delivery at anonymous shipping address and using debit account numbers/cards (see at least page 2, para 0026-page 5, para 0050).

(ii) US Pub.No: 2002/0046341 A1 to Kazaks et al. discloses a method and an apparatus for issuing prepaid payment cards to purchasers (see at least page 2, para 0012-page 4, para 0040).

(iii) US Patent 5, 822,737 to Ogram discloses an Internet system and method for purchasing and selling using a separate payment processing system (see at least col.1, line 1-col.3, line 19).

(iv) US Patent 6,125,353 to Yagasaki discloses purchasing and selling via Internet from a Virtual Mall server (see at least abstract).

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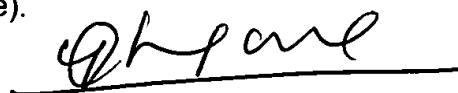
(v) Webpage: http://web.archive.org/web/20001018063328/www.cashx.com/cashx_splash.shtml extracted from Internet on 12/23/2003 discloses a web site allowing buyers to shop on-line with CashX-cards.

(vi) WO 99/63744 to Bond et al. discloses the use of a pre-paid card in a POS transaction (see at least abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Examiner
Art Unit 3625